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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.    | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------|------------------|
| 09/371,769  | 08/10/1999  | ERWIN HACKER         | 514413-3765            | 9638             |
| 20999   | 7590        | 01/03/2006           | EXAMINER               |                  |
| FROMMER LAWRENCE & HAUG<br>745 FIFTH AVENUE- 10TH FL.<br>NEW YORK, NY 10151 |             |                      | PRYOR, ALTON NATHANIEL |                  |
|   |             |                      | ART UNIT               | PAPER NUMBER     |
|   |             |                      | 1616                   |                  |

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/371,769

**Applicant(s)**

HACKER ET AL.

**Examiner**

Alton N. Pryor

**Art Unit**

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-74 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 13-16, 18, 19, 22, 29-31, 33, 34, 37, 40, 47-50, 59, 60, 62, 64, 67, 74 is/are rejected.
- 7) ☐ Claim(s) 52 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/9/01</u> . | 6) <input type="checkbox"/> Other: _____  |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 17-21,23-28,32,35,36,38,39,41-46,51,53-58,61,63,65,66 and 68-73.

### DETAILED ACTION

In light of amendment filed 11/10/05, a new ground of rejection is set forth below. Applicant is correct in that Ruegg (US 6180563) does not anticipate the instant invention. Examiner is setting forth a new ground of rejection (103 rejection) using Ruegg (US 6180563). Rejections using Ruegg (US 5965486) and Ruegg in combination with Tymonko (US 4822401) are withdrawn.

Applicant argues:

- a) Ruegg (US 6180563) is directed to a synergistic combination of an herbicide of formula I (trifloxysulfuron) and a substance of formula IV, e.g. glyphosate or glufosinate. Compositions were allowed for their showing of unexpected results for weed control based on this specific combination.
- b) Ruegg does not disclose compositions which contain the applicant's (B) herbicides nor is there any evidence that such a combination would maintain the unexpected results disclosed by Ruegg for their specific invention.
- c) Ruegg (US 5965486) teaches synergistic combinations of fluthiacet with glyphosate or glufosinate. Ruegg does not teach or suggest the inclusion of instant B herbicides in compositions comprising glyphosate or glufosinate. Examiner agrees with Applicant. Therefore, rejections using Ruegg and Ruegg in combination with Tymonko (US 4822401) are withdrawn.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-126,18,19,22,29-31,33,34,37,40,47-50,59,60,62,64,67,74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruegg et al (US 6180563; 1/30/01).

Ruegg teaches a method for controlling weeds in crops including cotton comprising applying to the crop a composition comprising trifloxysulfuron plus at least one compound including glyphosate, glufosinate, prometryn, MSMA, pendimethalin, and clomazone. See abstract, column 1 line 5 – column 6 line 35, column 11 line 32 – column 12 line 21. Ruegg does not teach or suggest an explicit method or composition for controlling weed in cotton comprising applying to cotton a composition comprising glyphosate or glufosinate and prometryn, MSMA, pendimethalin, and/or clomazone. However, it would have been obvious to one having ordinary skill in the art to make instant invention comprising trifloxysulfuron plus glyphosate or glufosinate plus prometryn, MSMA, pendimethalin, and/or clomazone. One would have been motivated to do this because Ruegg suggests the combination of ingredients and the herbicidal effectiveness of the combination would have been broaden as a result of the combination. Regarding applicant's argument in a) above, instant claims are open to the inclusion of trioxysulfuron since instant claims employ comprising language. In addition, claimed combinations of herbicides in compositions and methods are known individually

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to function as herbicides. Therefore, in the absence of unexpected results, it would have been obvious to combine ingredients having the same utility. Regarding applicant's argument in b) above, Ruegg does suggest the inclusion of at least one additional herbicides including glyphosate, glufosinate, prometryn, MSMA, pendimethalin, and/or clomazone in the composition comprising trioxysulfuron. The fact that all compounds being combined are herbicides suggests that the combination would have been effective. Combinations of compounds having the same utility are expected to give at least an additive effect.

***Claim Objection / Allowable Subject Matter***

Claims 52 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant has provided unexpected results for elected invention comprising glufosinate plus pyriithiobac. Other allowable combinations for which the applicant has provided unexpected results are glufosinate plus imazamox, pendimethalin, fluomethuron, bromoxynil, lactofen, cycloxydim and metolachlor.

***Other Matters***

Claims 29-46 depend from cancelled claim 1. Correction is necessary.

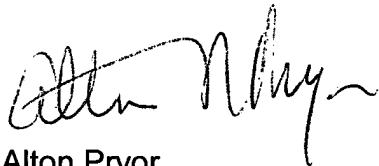
***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Alton Pryor', with a stylized flourish at the end.

Alton Pryor  
Primary Examiner  
AU 1616